

## **REMARKS**

Support for the amendment of claims 1 and 10 may be found in Applicants' specification as originally filed. No new matter has therefore been introduced.

In the Office Action dated 04/21/05, the Examiner has rejected claims 1-4, 6, 8-15, and 17-31. After entry of the preceding amendments, claims 1-4, 6, 8-15 and 17-31 remain pending in the application. Reconsideration of previously pending claims 1-4, 6, 8-15 and 17-31 and allowance of all claims 1-4, 6, 8-15 and 17-31 is respectfully requested.

As a preliminary matter, Applicants appreciate the courtesy extended by the Examiner on 02/27/2006 to permit submission of Applicants' Response to the pending Office Action and re-engagement of prosecution without the filing of a Petition.

*Applicants' respectfully request that the Office take administrative notice for potential Appeal that no fewer than four (4) references have now been cited in support of rejection of Applicants' claims under §103(a). The most recently added reference (Nardolillo) was returned in response to arguments raised by Applicants' in their Response to the Office Action date 11/30/2004. The fact that so many references have now been cited by the Examiner in attempts to advocate rejection of Applicants' invention should evidence the fact that Applicants' invention is indeed non-obvious.*

### **35 USC § 102**

Applicants now assume that there are no remaining references that the Examiner wishes to cite in support of potential prior art rejections under 35 U.S.C. §102.

### **35 USC § 103(a)**

Claims 1-4, 6, 8-15 and 17-31 stand rejected under 35 U.S.C. §103(a) as being unpatentable over various references, including: Kaplan (U.S. Patent No. 5,047,232); Miller (U.S. Patent No. 4,286,609); Arquette

(U.S. Patent No. 5,968,530); and Nardolillo (U.S. Patent No. 6,471,951B1). Applicants respectfully traverse.

The Examiner asserts that Kaplan teaches cosmetic emollients consisting of jojoba oil, lanolin oil, coconut oil, olive oil, liquid lanolin and cottonseed oil. The Examiner further proposes that Kaplan teaches “semi-solid cosmetic emollients which include hydrogenated lanolin, petrolatum, isopropyl lanolate, butyl myristate, cetyl myristate, cetyl alcohol and isocetyl lanolate”.

The Examiner acknowledges that Kaplan is silent with respect to the teaching of temperature range; however, with respect to Applicants’ independent claims, the presence or absence of any teaching in Kaplan as to a temperature range is deemed *non sequitur*. See Applicants’ Response to the Office Action dated 11/30/2004.

The Examiner’s assertion that Kaplan teaches the use of semi-solid emollients (presumably in the context of topical application) at col. 3, lines 49-54 and col. 4, lines 12-20 is incorrect. In appreciation of the difficulty of delivering solid and semi-solid formulations, Kaplan states at column 4, lines 12-15 that “solid or semi-solid” compounds may be used in accordance with Kaplan’s invention “*if admixed with mineral oil in amounts sufficient to provide liquid topical compositions*” (emphasis added). Indeed, skilled artisans would be left to conclude that “solid or semi-solid” compounds may *only* be used in accordance with Kaplan’s teaching if mixed with a liquid thinning agent in order to render the resulting mixture capable of being dispensed and applied in accordance with the teaching and disclosure of Kaplan (i.e., “liquid topical composition[s]”). See, for example, Kaplan at column 4, lines 12-15. Accordingly, topical application of a semi-solid emollient, as disclosed and claimed in Applicants’ instant application, would render the invention of Kaplan inoperable for its intended purpose – namely, the topical application of sunscreen compositions capable of being dispensed and delivered *in liquid phase*.

Kaplan does not teach or otherwise disclose a “cuticle treatment and conditioning composition”, much less “a semi-solid emollient having esterified compounds at least partially derived from [...] natural seed and nut oils”.

The discussion with respect to additional compositional components including dyes, colorants, perfumes and antioxidants is irrelevant with respect to Applicants’ independent claims 1, 10 and 24.

Nowhere does Kaplan (even taken in combination with Miller, Arquette and/or Nardolillo) teach or disclose a “cuticle treatment and conditioning composition” in accordance with Applicants’ invention.

Furthermore, Kaplan (even in combination with the remaining cited references) does not teach or disclose a semi-solid emollient comprising esterified components at least partially derived from natural seed or nut oils.

Applicants hereby incorporate their previous Response to the Office Action dated 11/30/2004 (as it pertains to Kaplan) by this reference.

The Examiner asserts that the Miller reference discloses a cylindrical container for use with hot oil cuticle treatments using animal and vegetable oils, proteins, vitamins and other ingredients. The Examiner further proposes that the act of dispensing the hot oil treatment composition past an opening in a cylindrical container or “extruding” the hot oil composition past the opening and replacing the cap on the container would be obvious to skilled artisans. Even if true, the Examiner’s assertions with respect to the Miller reference are irrelevant; however, notably and significantly, the cylindrical container of Miller corresponds to a *liquid storage bottle* 26 depicted in Figures 1 and 3 of that reference, and not an applicator adapted to deliver a semi-solid extrudate.

Applicants are affirmatively unaware as to why the Examiner has chosen to use the phrase “extruding” in the context of the hot oil treatment disclosed by Miller (even if taken in combination with the Arquette reference or any other reference of record). Skilled artisans appreciate that ‘extrusion’ generally refers to the process of forcing or drawing a material out of a containment reservoir in a manner that permits a suitably adapted material (*e.g.*, a semi-solid composition) exiting the reservoir opening to effectively conform to the shape of the opening. See, for example, Merriam-Webster’s Dictionary online (<http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=extruding>) and The American Heritage Dictionary, Second College Edition, 1985, Houghton Mifflin Company, Boston.

The Examiner admits that Miller does not teach the use of jojoba esters. This is particularly important, given the fact that the use of jojoba esters in accordance with Applicants’ invention would not be suitably adapted for application as a liquid hot oil in accordance with Miller.

Applicants hereby incorporate their previous Response to the Office Action dated 11/30/2004 (as it pertains to Miller) by this reference.

The Examiner asserts that Arquette teaches an emollient composition produced from fatty alcohols, isopropyl esters and wax esters. The Examiner further asserts that Arquette teaches emollient compositions that may be used as carriers. The Examiner also proposes that Arquette teaches the use of

additives such as fragrances, pigments, antimicrobial agents, antibacterial materials, pheromones, anti-inflammatory agents, sun blocks, sun screens and insect repellants. The Examiner also asserts that Arquette discloses a process for making an emollient using the steps of providing jojoba oil, adding an alcohol, effecting alcoholysis of the oil, and effecting interesterification of the remaining wax esters. Even if true, the Examiner's assertions are irrelevant for reasons discussed *vide infra*.

The Examiner has previously acknowledged that Arquette does not teach a container for retaining an emollient composition; and presumably, having failed to establish a *prima facie* case for obviousness in the previous Action, the Examiner now relies on Nardolillo for that missing element.

Applicants hereby incorporate their previous Response to the Office Action dated 11/30/2004 (as it pertains to Arquette) by this reference.

The Examiner asserts that Nardolillo teaches an eyebrow pencil containing wax bases such a jojoba wax, synthetic wax, and other traditional waxes and fatty esters. The Examiner concludes that "[i]t would have obvious to one of ordinary skill in the art at the time the invention was made to modify the Miller reference, to include jojoba esters and to include a container that retains the semi-solid emollient taught by Arquette and Nardolillo, having the reasonable expectation of obtaining a semi-solid emollient composition which comprises jojoba esters, known for the purpose of treating the cuticles and for moisturizing the tissues surrounding the nails, and one expect to achieve similar beneficial results." Applicants are affirmatively unaware of the meaning of the phrase "and one expect to achieve similar beneficial results". Clarification on this point is respectfully requested so that the record of prosecution is rendered clear for potential Appeal.

Furthermore, Applicants are affirmatively unaware of where in the Arquette reference a container that retains semi-solid emollients is disclosed. Clarification on this point is respectfully requested so that the record of prosecution is rendered clear on potential Appeal. Specifically, the Examiner explicitly stated in the previous Action, dated 11/30/04, on page 4, "***Arquette does not specifically teach a container that retains the semi-solid emollient***" (emphasis added). The Applicants respectfully submit that the Examiner may have misstated their assertions in the presently pending Office Action and that, in fact, there is no teaching in Arquette concerning a container that retains semi-solid emollients.

As for the Nardolillo reference, Nardolillo does not teach compositions and methods for cuticle treatment. Rather, Nardolillo teaches eyebrow pencils with agglomerated pigments. *See*, for example, the Figures,

Claims and specification of the Nardolillo reference. Nowhere in the Nardolillo reference is a cuticle treatment taught or otherwise suggested.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (MPEP §2143). Additionally, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In the instant case, the Examiner has failed to establish a *prima facie* case of obviousness.

It should be noted that any permutative combination of the elements of Miller, Arquette and Nardolillo would not produce a material capable of satisfying the requirements of an extrudate. Specifically, a liquid oil (as disclosed in Miller) would not conform and retain its shape upon pouring from storage bottle 26 (and also would not be suitably adapted for delivery from an eyebrow pencil). One of the definitional requirements of a 'liquid' is that such a material must flow and move to conform to the shape of a receiving or containment volume. *See, for example*, Merriam-Webster's Dictionary online (<http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=liquid>), where a liquid is defined as:

“[noun:] a fluid (as water) that has no independent shape but has a definite volume and does not expand indefinitely and that is only slightly compressible”

Semi-solid extrudates, on the other hand, do demonstrate independent shape corresponding to the geometry of the dispensing opening.

If given the compositions of toothpaste and mouthwash and told to assign them to a category corresponding to either 'liquid' or 'semi-solid' states of matter, skilled artisans would be able to make the same classification no doubt clearly evident to the Examiner. Accordingly, Applicants respectfully request that the Examiner replace the word “extruding” of the pending Office Action with a more appropriate word corresponding to delivery of a liquid, such as, for example: “decanting” or “pouring” in

keeping with the disclosure of Miller. *See also, for example*, Figure 3 in Miller, which clearly depicts the action of decanting or pouring a liquid.

Applicants submit that any alternative, conjunctive or sequential combination of Kaplan, Miller, Arquette and Nardolillo does not teach or suggest a cuticle treatment and conditioning composition consisting essentially of a semi-solid emollient having esterified compounds at least partially derived from natural seed and nut oils, as set forth in Applicants' claims. Additionally, there is no motivation or suggestion to be found in Kaplan, Miller, Arquette or Nardolillo, nor in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the references with each other, or any other reference of record, to practice the invention of claims **1**, **10** and **24**.

As the Examiner is aware, any basis for rejecting claims utilizing general knowledge, common sense or 'logical ideas' that originate with the Examiner, and not in the references themselves or the knowledge generally available to skilled artisans, is impermissible. Specifically, "with respect to core factual findings in a determination of patentability, [the Examiner] cannot simply reach conclusions based on [his/her] own understanding or experience – or on [his/her] assessment of what would be basic knowledge or common sense. Rather [the Examiner] must point to some concrete evidence in the record in support of [the] findings." *In re Zurko*, 258 F.3d 1379 (2001).

Additionally, under the second element established under MPEP §2143, since there is no motivation or suggestion to combine the cited reference with each other (or with any other reference of record), there can be no expectation of success at all – much less a "reasonable" expectation of success. Any expectation of success, absent a motivation or suggestion to combine, would be unreasonable at best. Accordingly, claims **1**, **10** and **24** may not properly be considered as obvious under §103(a). Applicants therefore respectfully request that the §103(a) rejection of claims **1**, **10** and **24** be withdrawn.

Notwithstanding the preceding, even if the cited reference were to be combined, the resulting combination would not correspond to Applicants' invention. Specifically, combination of the cited references does not disclose, teach or otherwise suggest a cuticle treatment and conditioning composition consisting essentially of a semi-solid emollient having esterified compounds at least partially derived from natural seed and nut oils (emphasis added). Rather, the combination proposed by the Examiner would result in an absurdly adapted hot oil eyebrow pigment – not Applicants' invention.

It is important to note that the Examiner has not identified (in any of the references) any suggestion that a semi-solid emollient comprising esterified compounds may be used for cuticle treatment. Furthermore, it is important to note that the cuticle stick that the Examiner references in Miller at column 2, lines 3-23 is not adapted for containment and delivery of a semi-solid composition. The cuticle stick 16 referenced by the Examiner in the pending Action, appears in Figure 1 of Miller. Miller's cuticle stick 16 is a conventional cuticle stick that has been commercially available for several decades. The cuticle stick 16 disclosed by Miller is used solely for pushing back the user's cuticles, not storing or delivering a cuticle treatment preparation. This is further illustrated in Miller's Figure 6, where the action of the user pushing back their cuticles with the soft rubber tip 34 of stick 16 is depicted in conjunction with the prior step of 'fingertip soaking' taught by Miller. Note also in Figure 3 of Miller that the fingertip soaking solution contained in storage bottle 26 is "poured" (*i.e.*, in liquid phase) from the containment vessel 26 into the receiving area 12 for subsequent fingertip soaking. Accordingly, the proposed combination of the cited references would suggest that suitable emollient compositions for use with cuticle treatments would occur in liquid phase – and thereafter or alternatively be subsequently dispensed as a liquid from an eyebrow pencil in accordance with Nardolillo? If this were the case, the technology disclosed by Miller would not operate for its intended purpose – namely, providing a fingertip soak; and the technology disclosed by Nardolillo would not operate for its intended purpose – namely, providing an eyebrow pencil adapted for delivery of pigments.

The Examiner has previously acknowledged that Arquette does not teach a container that retains a semi-solid emollient – thereafter, ostensibly looking to the Miller and Nardolillo references to provide this missing feature (*i.e.*, constructing an argument along the lines of 'Arquette purportedly has the compositional material' and 'either Miller or Nardolillo purportedly has the delivery device'). The Examiner also proposes that the references teach separate compositions that may be combined in order to obtain a composition corresponding to Applicant's invention (*e.g.*, constructing an argument along the lines of 'Arquette purportedly has a first compositional component of the material' and 'Miller purportedly has the second missing compositional component'). Does the Examiner suggest that Applicants' cuticle treatment compound is compositionally disclosed entirely in the Arquette reference, or that Applicants' cuticle treatment compound is compositionally disclosed as a combination of component parts separately found in the Arquette, Miller and Nardolillo references? Respectfully, the Examiner cannot have it both ways – and in either case, the combination of Kaplan, Miller, Arquette and Nardolillo would not result in or otherwise produce Applicants' invention.

Notwithstanding the preceding confusion as to what the Examiner intends to communicate, even if the teaching of Arquette were to be combined with the remaining cited references, the resulting combination would not correspond to Applicants' invention. Specifically, the combination of cited references does not disclose, teach or otherwise suggest a cuticle treatment and conditioning composition consisting essentially of a semi-solid emollient having esterified compounds at least partially derived from natural seed and nut oils (emphasis added). Furthermore, the cited references may not be properly combined since there is nothing in their disclosures that would teach combination or any reason for it; moreover, the combination of the proposed references would destroy the inventive technology disclosed in the Miller and Nardolillo references for their intended purposes as discussed *vide supra*. See, for example, *Ex parte Sternau*, 155 USPQ 733 (POBA 1967).

Accordingly, Applicants respectfully request that the Examiner withdraw the §103(a) rejection of claim 1 as amended.

Inasmuch as claims 2-4, 6, 8 and 9 depend from, further limit and incorporate all of the elements and limitations of claim 1 as amended, these claims are also allowable over the cited references. Applicants therefore submit that claims 2-4, 6, 8 and 9 are allowable and respectfully request that the Examiner withdraw the §103(a) rejections of the same.

Applicants also respectfully request that the Examiner withdraw the §103(a) rejection of claim 10 as amended.

Inasmuch as claims 11-15 and 17-23 depend from, further limit and incorporate all of the elements and limitations of claim 10 as amended, these claims are also allowable over the cited references. Applicants therefore submit that claims 11-15 and 17-23 are allowable and respectfully request that the Examiner withdraw the §103(a) rejections of the same.

Applicants also respectfully request that the Examiner withdraw the §103(a) rejection of claim 24.

Inasmuch as claims 25-31 depend from, further limit and incorporate all of the elements and limitations of claim 24, these claims are also allowable over the cited references. Applicants therefore submit that claims 25-31 are allowable and respectfully request that the Examiner withdraw the §103(a) rejections of the same.



## **CONCLUSION**

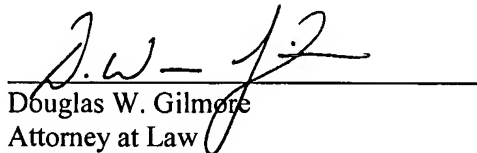
The cited references have been reviewed and are not believed to affect the patentability of the claims as amended. Claims 1-4, 6, 8-15 and 17-31 are pending in the application. Reconsideration of previously pending claims 1-4, 6, 8-15 and 17-31 and allowance of all claims 1-4, 6, 8-15 and 17-31 is earnestly requested.

No amendment made herein was related to the statutory requirements of patentability unless expressly stated; rather any amendment not so identified may be considered as directed *inter alia* to clarification of the structure and/or function of the invention and Applicants' best mode for practicing the same. Additionally, no amendment made herein was presented for the purpose of narrowing the scope of any claim, unless Applicant has affirmatively argued that such amendment was made to distinguish over a particular reference or combination of references. Furthermore, no election to pursue a particular line of argument was made herein at the expense of precluding or otherwise impeding Applicant from raising alternative lines of argument later during prosecution, Appeal or litigation. Applicant's failure to affirmatively assert specific arguments is not intended to be construed as an admission to any particular point raised by the Examiner.

Should the Examiner have any questions regarding this Response and Amendment or feel that a telephone call to the undersigned would be helpful to advance prosecution in this matter, the Examiner is invited to call the undersigned at the number given below.

Respectfully submitted,  
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Date: 02/28/2005

  
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